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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,309	03/25/2004	Naoki Hasegawa	20-137	5487
7590	01/24/2006	EXAMINER		
Arnold International		SMITH, PHILIP ROBERT		
P.O. Box 129		ART UNIT		
Great Falls, VA 22066		PAPER NUMBER		

3739

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/808,309

Applicant(s)

HASEGAWA, NAOKI

Examiner

Philip R. Smith

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Restrictions**

[01] Restriction to one of the following inventions is required under 35 U.S.C. 121:

[01a] Claims 1-2, 11, 13 & 16, drawn to an endoscope observation system, classified in 600/160.

[01b] Claims 3-7, drawn to an endoscope having non-overlapping illumination and observation fields, classified in 600/176.

[01c] Claims 8-10,12 drawn to a diagnostic method, classified in 600/476.

[01d] Claims 14-15, drawn to an endoscope with LED illumination, classified in 600/178.

[02] The inventions are distinct because of the following reason:

[02a] Inventions [01a] and [01b] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention [01b] has separate utility in a white-light endoscope. See MPEP § 806.05(d). It is necessary to search for dual wavelength illumination bands in places where no pertinent art to non-overlapping illumination and observation fields exists, therefore causing a serious burden to the examiner.

[02b] Inventions [01a] and [01c] are related as subcombinations disclosed as usable together in a single combination, as are [01b] and [01c]. The

subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention [01a] or [01b] has separate utility in a endoscopic method which does not require the introduction of coloring agent. See MPEP § 806.05(d). It is necessary to search for coloring agents in places where no pertinent art to objective optical systems with image scale factors greater than 1 exist, therefore causing a serious burden to the examiner.

[02c] Inventions [01a] and [01d] are related as subcombinations disclosed as usable together in a single combination, as are [01b] and [01d]; [01c] and [01d]. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention [01a], [01b] or [01c] has separate utility in an endoscope or endoscopic method having a white-light illumination source. See MPEP § 806.05(d). It is necessary to search for LED light sources in places where no pertinent art to objective optical systems with image scale factors greater than 1 exist, therefore causing a serious burden to the examiner.

### **Conclusion**

[03] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.

[04] If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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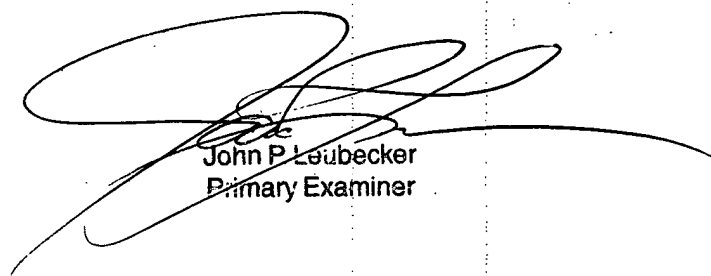
supervisor, Linda Dvorak can be reached on (571) 272 4764.

[05] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

[06] prs



John P. Leubecker  
Primary Examiner